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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,052	08/28/2001	Jorg Schlieffers	1206	5662

7590 04/09/2003
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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,052

Applicant(s)

SCHLIEFFERS, JORG

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 are presented for examination.
2. Upon reviewing of the parent application Serial No. 09/835,733, the examiner has determined that the currently claimed invention has not been "wholly" disclosed until the current application. Specifically the distal end including a spacer which is a rubberized lip that limits a distance between the optical scanner and a surface of one of the object placed against the device to be scanned, a resilient member forming an eyelet for supporting the device, and a resilient member forming a hook for supporting the device or a suspension portion for suspending the housing from a support projection when not scanning are not found in the parent application. Therefore, the effective filing date for the currently claimed invention is 8/28/01.

Oath/Declaration

3. It appears that applicant is claiming the domestic priority of benefit under 35 U.S.C. Section 120 and/or 121. The PTO record shows that this application is a continuation-in-part of US Patent Application Serial no. 09/835,733 filed 4/6/01, which is pending; which a continuation of US Patent Application Serial no. 09/528,239, which issued as U.S. Patent No. 6,244,513; which a continuation of US Patent Application Serial no. 09/436,169, which issued as U.S. Patent No. 6,123,265; which a continuation of US Patent Application Serial no. 08/883,357, which issued as U.S. Patent No. 5,979,790. Please provide an updated oath, declaration or application data sheet to acknowledge and identify the parent application in next communication.

Specification

4. The disclosure is objected to because of the following informalities:
 - (a) Page 1, lines 10+: The following phrase should be inserted after "assignee":

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--, which is pending; which a continuation of US Patent Application Serial no. 09/528,239, which issued as U.S. Patent No. 6,244,513; which a continuation of US Patent Application Serial no. 09/436,169, which issued as U.S. Patent No. 6,123,265; which a continuation of US Patent Application Serial no. 08/883,357, which issued as U.S. Patent No. 5,979,790--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9, 11, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. [US 5,828,052-referred as Reynolds].

Re claims 1, 11, and 14: Reynolds discloses a bar code optical scanning device 20, comprising:
a body having

a distal end (i.e., front end of the scanning device having a window 64 and a forwardly extending portion 66 located in a top forward portion of the head 22),

a proximal end (i.e., rear end of the scanning device 20 having a lower bumper 34' and an end cap 28),

said body is adapted to be held in a hand of a user by the body (e.g., a handle 26 portion) being gripped between the distal and proximal ends, and

a optical scanner disposed therein and arranged to optically scan remote objects located in a direction which is outward from the distal end (i.e., through the window 64) (see figure 5); and

a first resilient member (i.e., the upper bumper 34 of elastomers to protect underlying surface of the scanner) located at said distal end and including a spacer (i.e., the forwardly extending portion 66) which limits a distance between the optical scanner and the objects to be scanned (i.e., the optical depth would be at least the distance from the scan engine to the end of the forwardly extending portion 66).

Reynolds does not explicitly show the surface of the remote objects placed against the device to be scanned.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the remote object having a bar code thereon to be scanned would be placed against the device in order to properly position the reader toward the bar code to carry out the reading operation.

Re claims 2 and 8: Wherein an upper surface of the body includes a light transmissive visual indicator 37, an acoustic outlet 41, and wherein the body having a hilt 24, which is contoured to comfortably fit into the hand of the user (see figure 7);

Re claim 3: The lower portion of the body includes a trigger 60 (see figure 3-6);

Re claim 4: The body includes a housing having a separable portions (see col. 3, lines 8+ and figure 4);

Re claims 5-6: The first resilient member includes the upper bumper 34 and the forwardly extending portion 66 of elastomers that protect underlying surface of the scanner located at said distal end, therefore, the upper bumper 34 and the forwardly extending portion 66 provides serves the claimed function of a ridge that formed on the first resilient member forming a first rest stand when user place the device on a working surface.

Re claim 7: The body having a handle 26 on which the second resilient member (i.e., at rear end of the scanning device 20 having a lower bumper 34' and an end cap 28 of elastomers to protect the underlying surfaces of the scanner 20) servers the claimed function of a further ridge forming a second rest stand for use in cooperation with the first rest stand when user place the device on a working surface.

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Re claims 9 and 16-18: The second resilient member forms an eyelet (i.e., an opening, shown in figures 5-6, 8-9 but the specific reference number not assigned) for supporting the housing (i.e., the opening at the end cap of the proximal end of the reader may be optionally used for suspending the reader from a support projection such as a nail, a hook, and etc. when not scanning.

Re claim 15: Reynolds fails to teach the bar code reader is a laser scanning device.

However, the laser scanning bar code reader is notoriously old and well known, therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide a laser scanning means in the scanning reader of Reynolds in order to provide a coherent illuminating mean for an accurate and an effective reading operation.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Meksavan et al. [US D458,263 S]. The teachings of Reynolds have been discussed above.

Although Reynolds show the eyelet (i.e., an opening, shown in figures 5-6, 8-9 but the specific reference number not assigned) extends to a lengthwise direction of the body, he does not specifically show the eyelet extends orthogonal direction of the body.

Meksavan shows the opening/eyelet extends orthogonal direction of the bar code scanning body (see figures 1-4).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the design shape of Meksavan in the teaching of Reynolds to provide a greater suspending means so that user can easily suspend the reader.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds in view of Yamanoto [US D293,795]. The teachings of Reynolds have been discussed above.

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Although Reynolds teaches the spacer (i.e., the forwardly extending portion 66) of elastomers is a rubberized material disposed along a lower edge of the first resilient member, he fails to teach the spacer having a shape of lip.

Yamamoto shows the distal end of the reader having a spacer (i.e., an extending portion) formed to surround the opening/window of the reader, i.e., the spacer having a shape of lip (see figures 1-2).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamamoto in the teaching of Reynolds in order to increase the protecting coverage area of the window of reading reader. Such modification would have been further prevented the damage during dropping of the reader.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,123,265 in view of Reynolds and Meksavan. The teachings of Reynolds, Meksavan, and Yamamoto have been discussed above.

Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,123,265 teaches all claimed limitation of the instant application except for the

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followings: a laser scanning bar code reader, an acoustic outlet, at the upper surface of the body, and a spacer that is a rubberized lip disposed along a lower edge of the device.

Reynolds teaches a laser scanning bar code reader, an acoustic outlet, at the upper surface of the body, and a spacer that is a rubberized lip disposed along a lower edge of the device (see the discussion above).

Meksavan teaches the an eyelet extending orthogonal to a lengthwise direction of the body (see the discussion above).

Yamamoto shows the distal end of the reader having a spacer (i.e., an extending portion) formed to surround the opening/window of the reader, i.e., the spacer having a shape of lip (see figures 1-2 and the discussion above).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Reynolds, Meksavan, and Yamamoto in the teaching of U.S. Patent No. 6,123,265 in order to further improve the structural design of the reader.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

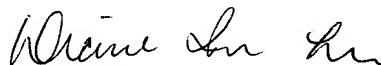
Massieu et al. [US D406 126 S], Kitazumi et al. [US D357,240 S], and Schmidt et al. [US D408,532] discloses a reader having a spacer (i.e., an extending portion) formed to surround the opening/window of the reader, i.e., the spacer having a shape of lip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.
March 31, 2003